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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,798	01/21/2004	Cherie R. Kagan	YOR920000186US2	9993
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PAUL D. GREELEY, ESQ. OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P. 10th FLOOR ONE LANDMARK SQUARE STAMFORD, CT 06901-2682		EXAMINER CHAN, SING P		
		ART UNIT 1734		
		MAIL DATE 06/01/2007		
		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,798

Applicant(s)

KAGAN ET AL.

Examiner

Sing P. Chan

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-13 and 22-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment added the limitation of "said self-assembled monolayer is formed...without forming a covalent bond between the said self-assembled monolayer and said thin film" is not supported by the cited section of the Specification and seems to suggest the self-assembled monolayer does not form a covalent bond, furthermore, the cited section of Specification recites "there is no covalent chemical bond formed between the thin film and the substrate," which seem to suggest that it is the thin film that does not form a covalent bond with the substrate. The recitation of "without forming a covalent bond between said self-assembled monolayer and said thin film" is a negative recitation and required the Specification is required to recite the limitation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-11, 22, 23, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Clem et al (U.S. 6,518,168).

Regarding claims 1, 5, 7, 8, 22, and 29, Clem et al discloses a method of forming self-assembled monolayer or SAM and thin film on surfaces. The method includes forming a pattern onto a substrate with an applicator, i.e. a stamp, by coating the SAM onto the protrusions of the stamp, applying the stamp to the substrate and removing the stamp from the surface of the substrate, applying a sol-gel precursor to the SAM coated substrate by dip coating or spin casting and after heat treatment, forming an amorphous oxide film at the unpatterned region, i.e. thin film, but the patterned region with the SAM, the thin film adhered poorly and easily removed by thermal and/or mechanical agitation, i.e. without forming covalent bonding (Col 6, lines 14-36), wherein the thin film is in the order of micron or submicron range (Col 5, lines 46-55), which is not a monolayer. Furthermore, Clem et al recites the SAM includes a first end with functional group that binds to the desired surface (Col 10, lines 27-30) and a second end with functional

group that selected to bind to particular material in any of a variety of functionalities (Col 11, lines 326-39), for example a prepolymer may be applied to the surface wherein the prepolymer is compatible with the exposed functionality of the SAM and incompatible with the surface of the substrate, the prepolymer assembles on the SAM and then can be polymerized but if the prepolymer is incompatible with the functionality of the SAM and compatible with the surface of the substrate, the prepolymer will assemble in a pattern complementary to the pattern of the SAM (Col 18, line 56 to Col 19, line 21) and therefore, does not form covalent bonding.

Regarding claim 2, Clem et al discloses the substrate includes conductive, nonconductive, semiconducting material, glass, silica, alumina, plastic, and organic polymers. (Col 13, lines 3-15)

Regarding claims 3 and 4, Clem et al discloses the substrate includes curved or non-planar substrate. (Col 8, lines 60-67)

Regarding claim 6, Clem et al discloses the stamp is elastic. (Col 15, lines 36-45)

Regarding claim 9, Clem et al discloses the SAM includes at least one sulfur-containing functional group such as thiols, sulfide, or disulfide. (Col 11, lines 24-27)

Regarding claims 10 and 11, Clem et al discloses the second end of the SAM or tail of SAM includes functional groups such as polar, nonpolar, halogenated, hydrocarbon, and amine. (Col 11, line 36 to Col 12, line 23)

Regarding claim 23, Clem et al discloses the material deposited includes metal oxide. (Col 5, lines 46-51 and Col 6, lines 49-59)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clem et al (U.S. 6,518,168) as applied to claim 5 above, and further in view of Chrisey et al (U.S. 5,688,642).

Clem et al discloses the molecular species for the SAM includes "fluorinated hydrocarbon" (See Clem, Col 11, lines 56-63). But, is silent as to the 'fluorinated hydrocarbon' includes (tridecafluoro-1,1,2,2-tetrahydrooctyl) trichlorosilane. However, using (tridecafluoro-1,1,2,2-tetrahydrooctyl) trichlorosilane for SAM is well known and conventional as shown for example by Chrisey et al. Chrisey et al discloses a method of selective attachment of nucleic acid molecules to patterned self-assembled surfaces. The method includes forming a thin film of organosilane (SAM) using (tridecafluoro-1,1,2,2-tetrahydrooctyl)trichlorosilane to form the SAM on a silica slide. (Col 10, lines 29-35)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide (tridecafluoro-1,1,2,2-tetrahydrooctyl) trichlorosilane as a molecular species for forming SAM on a substrate as disclosed by Chrisey et al in the method of Clem et al to provide a method of preparing surfaces, which nucleic acid

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molecules (NAMs) may be immobilized to form arrays or patterns of NAMs. (See Chrisey et al, Col 3, lines 26-31)

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clem et al (U.S. 6,518,168) as applied to claim 5 above, and further in view of Wefers et al (U.S. 5,059,258).

Clam et al discloses molecular species for the SAM includes hydrocarbon, fluorinated hydrocarbon, halogenated, and phosphate species, (See Clem et al, Col 11, lines 46-66) but, is silent as to the species is octadecylphosphonic acid. However, providing octadecylphosphonic acid as a species for forming SAM is well known and conventional as shown for example by Wefers et al. Wefers et al discloses a method of bonding phosphonic acid to aluminum hydroxide layer. The method includes providing a molecular species such as long and short chain hydrocarbon, carboxylic acids, amine, alcohols, organosilicones, polymeric phosphonic acids such as octadecylphosphonic acid, which will form a SAM. (Figure 1 and Col 4, lines 24-66)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide octadecylphosphonic acid as the molecular species for forming SAM on the substrate as disclosed by Wefers et al in the method of Clem et al to provide any molecular species, which are all equivalents to form the SAM on the substrate.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clem et al (U.S. 6,518,168) as applied to claim 23 above, and further in view of Liang et al (U.S. 5,871,579).

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Clem et al as disclosed above of using amines as a functional group on SAM but is silent as to the amines are organic-inorganic hybrid such as $(C_6H_5C_2H_4NH_3)_2SnI_4$, $(C_4H_9NH_3)_2CH_3NH_3Sn_2I_7$, $(C_6H_5C_2H_4NH_3)_2CH_3NH_3SnI_4$, $(H_3NC_4H_8NH_3)_2SnI_4$, and a mixture thereof. However, using organic-inorganic hybrid to form thin film is well known and conventional as shown for example by Liang et al. Liang et al discloses a method of forming organic-inorganic perovskite thin film. The method includes depositing a thin film of MI_2 onto a glass or quartz substrate (Col 3, lines 21-29), immersing the thin film into a solution of desired organic ammonium iodide to obtain the perovskite thin film or organic-inorganic hybrid of $(C_6H_5C_2H_4NH_3)_2SnI_4$, $(C_4H_9NH_3)_2CH_3NH_3Sn_2I_7$, $(C_6H_5C_2H_4NH_3)_2CH_3NH_3SnI_4$, and $(H_3NC_4H_8NH_3)_2SnI_4$. (Col 4, line 13 to Col 6, line 53)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide thin film of $(C_6H_5C_2H_4NH_3)_2SnI_4$, $(C_4H_9NH_3)_2CH_3NH_3Sn_2I_7$, $(C_6H_5C_2H_4NH_3)_2CH_3NH_3SnI_4$, and $(H_3NC_4H_8NH_3)_2SnI_4$ as disclosed by Liang et al in the method of Clem et al to provide a semiconductor layer with strong luminescence for building electrical device. (See Liang et al, Col 1, lines 31-44)

9. Claims 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clem et al (U.S. 6,518,168) as applied to claim 23 above, and further in view of Hawker et al (U.S. 6,423,465).

Clem et al as disclosed above is silent as to thin film is a photoresist. However, providing a photoresist on a monolayer is well known and conventional as shown for example by Hawker et al. Hawker et al discloses a method of forming patterned

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polymeric brush on a substrate surface. The method include forming the polymeric brush on the substrate the same way as self assembled monolayer, which is a monolayer of polymeric material (Col 1, lines 50-62), applying a polymer composition such as methyl methacrylate-co-methacrylic acid by spin coating or dip coating, applying a deep UV radiation to the decompose the photoacid generator and removing the remaining photoresist by washing with appropriate solvent. (Col 11, lines 18-67) Furthermore, photoresist coating is imagewise expose to the UV radiation (Col 11, lines 44-50) and inherently includes either a positive or a negative image of the desired pattern.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a photoresist on a monolayer of polymer brush and applying deep UV radiation to form either a positive or negative image pattern on the photoresist as disclosed by Hawker et al in the method of Clem et al to provide a processing technologies for semiconductor with extremely stable, high resolution, and versatile product. (See Hawker et al, Col 2, lines 37-40)

10. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clem et al (U.S. 6,518,168) as applied to claim 23 above, and further in view of Schildkraut et al (U.S. 5,115,336).

Clem et al as disclosed above is silent as to thin film is metallo-organic complex of tin 2-ethylhexanoate. However, providing a coating on a SAM with metallo-organic complex is well known and conventional as shown for example by Schildkraut et al. Schildkraut et al discloses a method of forming a photorefractive system. The system

includes an optically active layer formed by SAM (Col 12, lines 51-62) and forming a protective coating using metal fluoride coating by thermal decomposition of the metal carboxylate, i.e. metal acetate³ or 2-ethylhexanoate (Col 16, lines 5-9 and Col 16, lines 34-44), wherein the metal includes alkaline earth, rare earth, and alkali oxide and fluoride (Col 16, lines 9-26), which inherently includes tin as a rare earth metal.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a protective coating on the SAM using a metal 2-ethylhexanoate such as tin 2-ethylhexanoate as disclosed by Schildkraut et al in the method of Clem et al to provide a inert stable compounds as an protective layer for the SAM. (See Schildkraut et al, Col 16, lines 9-12)

Response to Arguments

11. Applicant's arguments filed March 163, 2007 have been fully considered but they are not persuasive.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., thin film is obtained in a single step process) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. In response to applicant's argument of Clem et al does not recite patterned thin film without forming a covalent bond between said self-assembled monolayer and said thin film, the examiner disagrees, since Clem et al does recite the SAM has functional

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ends with selective binding and show as example prepolymer, which can be bind to the SAM's functional group or if the prepolymer is incompatible with the SAM, the prepolymer is bind to the surface of the substrate. (See Clem et al, Col 18, line 56 to Col 19, line 21) Furthermore, the formation of the prepolymer pattern is done in a single step.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Chan Sing P

Chris Fiorilla
CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
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